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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,449	08/28/2000	Piotr Cofa	004770.00589	5441
22907 7590 03/12/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER LANIER, BENJAMIN E	
			ART UNIT 2132	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 03/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/648,449

Applicant(s)

COFTA, PIOTR

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,6-9,23,27-32 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6-9,23,27-32 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed 23 February 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: transmitting via said first communication pathway through said network from said token said information obtained from said control point and information regarding said token, said information being transmitted to said token issuer and said control point operator, said control point operator authenticating said token with said token issuer and said token issuer authenticating said control point with said control point operator.
2. Applicant's specification does not disclose an embodiment of the invention where the token collects control point information and transmits the collected information to the token and issuer and the control point operator. Figure 5 would appear to show this embodiment, however, upon a closer inspection of the portion of the specification (Page 9, lines 4-8) that describes figure 5 in detail, it is clear that the control point is communicating over the communications network with the control point operator and not the token as claimed. Additionally, the specification supports an embodiment where the control point collects information from the token and transmits the collected information to the control point operator for authentication of the token (Page 5, line 21 – Page 6, line 14 & Figure 4). Lastly the specification supports an embodiment where the control point collects information from the token to be transmitted to the control point operator, and the token collects information from the control point to be transmitted to the token issuer. However, no mention is made to an embodiment where the token collects

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information from the control point that is transmitted to both the control point and the token issuer, such that the control point operator authenticates the token and the token issuer authenticates the control point as claimed.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

3. Applicant's argument that the claim amendments have overcome the Geiger reference have been fully considered and are persuasive. However, upon further consideration, a new ground(s) of rejection is made in view of Whigham, U.S. Patent No. 6,584,309, in view of Asokan, U.S. Patent No. 7,149,895.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 4, 6-9, 23, 27-32, 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: transmitting via said first communication pathway through said network from said token said information obtained from said control point and information regarding said token, said information being transmitted to said token issuer and said control point operator, said control

point operator authenticating said token with said token issuer and said token issuer authenticating said control point with said control point operator.

6. Applicant's specification does not disclose an embodiment of the invention where the token collects control point information and transmits the collected information to the token and issuer and the control point operator. Figure 5 would appear to show this embodiment, however, upon a closer inspection of the portion of the specification (Page 9, lines 4-8) that describes figure 5 in detail, it is clear that the control point is communicating over the communications network with the control point operator and not the token as claimed. Additionally, the specification supports an embodiment where the control point collects information from the token and transmits the collected information to the control point operator for authentication of the token (Page 5, line 21 – Page 6, line 14 & Figure 4). Lastly the specification supports an embodiment where the control point collects information from the token to be transmitted to the control point operator, and the token collects information from the control point to be transmitted to the token issuer. However, no mention is made to an embodiment where the token collects information from the control point that is transmitted to both the control point and the token issuer, such that the control point operator authenticates the token and the token issuer authenticates the control point as claimed.

7. Claims 1, 4, 6-9, 23, 27-32, 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's specification does not disclose an embodiment of the invention where the token collects control

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point information and transmits the collected information to the token and issuer and the control point operator. Figure 5 would appear to show this embodiment, however, upon a closer inspection of the portion of the specification (Page 9, lines 4-8) that describes figure 5 in detail, it is clear that the control point is communicating over the communications network with the control point operator and not the token as claimed. Additionally, the specification supports an embodiment where the control point collects information from the token and transmits the collected information to the control point operator for authentication of the token (Page 5, line 21 – Page 6, line 14 & Figure 4). Lastly the specification supports an embodiment where the control point collects information from the token to be transmitted to the control point operator, and the token collects information from the control point to be transmitted to the token issuer. However, no mention is made to an embodiment where the token collects information from the control point that is transmitted to both the control point and the token issuer, such that the control point operator authenticates the token and the token issuer authenticates the control point as claimed.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 4, 6-9, 23, 27-32, 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whigham, U.S. Patent No. 6,584,309, in view of Asokan, U.S. Patent No. 7,149,895. Referring to claims 1, 6, 7, 9, 23, 27-32, 38, 39, Whigham discloses purchasing a product from a vending machine using a cellular telephone wherein the cellular telephone and the vending machine are connected via a local link (Figure 1, 112), which meets the limitation of a second wireless interface of said token, the control point is local to said token, the token is a mobile wireless communication device. The telephone is also connected to a server over a communications network (Figure 1, 122), which meets the limitation of a first wireless interface of said token. To purchase a product, the user approaches the vending machine that has the product that the consumer wishes to purchase (Col. 5, lines 51-57). From information displayed on or adjacent to the vending machine, the user is able to ascertain the identity of the product that he or she wishes to purchase, and the user proactively enters the product information into the cellular telephone to initiate purchasing procedures (Col. 5, line 57- Col. 6, line 6). Whigham does not disclose the user receives the product information from the vending machine over the local link. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the vending machine to transmit the desired product information over the local link to the user cellular telephone in order to reduce the burden of the user having to manually enter identification information into their cellular telephone, which would ultimately increase the convenience of the purchasing system. The cellular telephone communicates with the server and transmits the product information to the server (Col. 6, lines 7-9), which meets the limitation of

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transmitting via said first communication pathway using said first wireless interface through said network from said token said information obtained from said control point and information regarding said token, said information being transmitted to said network from said token. The server authenticates the user and transmits a vend code to the user that indicates the authentication of the user (Col. 6, lines 28-45 & Col. 7, lines 9-11), which meets the limitation of receiving at said token via said first communication pathway an authentication of said token.

Whigham does not specify authenticating the vending machine and providing proof of the authentication to the user. Asokan discloses a transaction system where users are provided with an authentication of a transaction terminal prior to use of that terminal (Abstract & Col. 3, lines 11-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an indication to the user that the vending machine is authentic in order to protect the user from potential theft of personal information as taught by Asokan (Col. 1, lines 16-40). The vend code is then transmitted by the consumer to the vending machine over the local link to provide the requested protect (Whigham: Col. 7, lines 14-30), which meets the limitation of transmitting to said control point said authentication of said token via said second communication pathway using said second wireless interface.

Referring to claim 4, Whigham discloses that part of the server side comprises a credit/debit card agency (Figure 1, 134), which meets the limitation of said mobile communication device communicates with a token issuer using a wireless communication path in at least part of said first communication pathway.

Referring to claim 8, Whigham discloses that access is provided to a vending machine. Vending machines contain locked doors so that only authorized personal can remove the



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collected bills and coins, and refill/remove products housed inside the vending machine, which meets the limitation of said authenticating comprises access control to a door, where said control point includes a door lock that controls operation of said door.

Referring to claims 36, 37, dictionary.com defines toll as being “a tax, duty, or tribute, as for services or use of facilities.” Whigham discloses the vending system includes billing information (Abstract), which meets the limitation of toll collecting because funds would be collected for the products offered by the vending machine.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

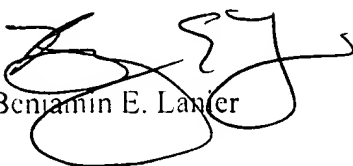
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Benjamin E. Lanier